

**REMARKS/ARGUMENTS****Claim Objections**

Claims 10 and 11 were objected to because claim 10 did not appear on the listing of claims filed in the response filed on June 30, 2003. The omission of claim 10 from the prior listing of claims was inadvertent. Claim 10 is amended herein as it was intended to be amended in the prior response.

**Claim Rejections – 35 USC §102**

Claims 1, 3, 5-8, 10, 11, 37, 39-41, 46, 47, 50, 51, and 54-57 were rejected as anticipated under 35 USC §102(e) by U.S. Patent 6,381,256 (Stamm). Applicants traverse this rejection because the Stamm patent does not have an effective filing date prior to that of the present application.

The Stamm patent was filed on June 22, 2000, which is the same date as the filing date of the present application. The Stamm patent is a continuation-in-part of two earlier applications, filed April 17, 2000 (09/550,558, now U.S. Patent 6,389,045) and May 24, 1999 (09/317,527, now U.S. Patent 6,154,470), respectively. The Stamm patent also claims priority to five provisional applications, filed as early as June 23, 1999 (60/140,531) and as late as May 15, 2000 (60/204,095). Furthermore, application 09/550,558 claims priority to one provisional application, and application 09/317,537 claims priority to two provisional applications. See Stamm patent, column 1, lines 6-20. The issue is what is the effective filing date of the Stamm patent? The October 15, 2003 Office Action takes no position on this issue.

The October 15, 2003 Office Action relies on Figure 5d and column 2, lines 56-61 (stating that a grism may be used in a line-narrowing module) to support the rejection. The undersigned attorney has reviewed the five provisional applications and the two non-provisional applications (and their corresponding three provisional applications) to which the Stamm patent claims priority. Of these, provisional application 60/140,531, filed June 23, 1999, is the earliest disclosure of Figure 5d of the Stamm patent. The review did not find any disclosure of using a grism in a line-narrowing module prior to the filing of application 09/599,130 on June 22, 2000, the application that resulted in the Stamm patent. Accordingly, the 102(e) date for Figure 5d of Stamm is no earlier than June 23, 1999, and the 102(e) date for column 2, lines 56-61 (the use of a grism in a line-narrowing module) of Stamm is no earlier than June 22, 2000.

Note that the effective filing date for the Stamm patent is not the filing date of provisional applications 60/120,218, 60/119,486, or 60/130,392, the provisional applications upon which non-provisional applications 09/317,537 and 09/550,558 claim benefit. First of all, Figure 5d and the disclosure of using a grism in a line-narrowing module is not contained in those provisional applications. Second, the non-provisional applications do not contain such disclosure either. These three provisional applications were filed before June 23, 1999, but since none contain the critical disclosure relied upon by the examiner, they do not establish an earlier effective filing date.

The present application was filed on June 22, 2000. It relies on four provisional applications, including 60/140,532, which was filed on June 23, 1999. Provisional application 60/140,532 supports the pending claims of the present application. June 23, 1999 is the same date upon which provisional application 60/140,531 was filed, which is the earliest possible 102(e) date of Stamm. These two filings on June 22, 2000 were made by the same law firm, Limbach & Limbach LLP.

The Examiner has failed to establish a *prima facie* case that the Stamm patent is prior art to the present application. The earliest possible 102(e) date of Stamm is June 23, 1999 for the content that the Examiner relies upon to reject the pending claims. That date is not prior to the effective filing date of the present application, which is June 23, 1999 because provisional application 60/140,532 supports the pending claims. Accordingly, the rejections based on Stamm are improper and should be withdrawn.

#### Claim Rejections – 35 USC §103

Claims 9, 12-36, 42-45, 48-53, and 56-61 were rejected as obvious under 35 USC §103(a) over U.S. Patent 6,381,256 (Stamm) in view of U.S. Patent 5,080,465 (Laude).

The Stamm patent is assigned to Lambda Physik AG of Goettingen, Germany and is considered by the Examiner to be prior art under 35 USC §102(e). The present application is also assigned to Lambda Physik. See attached assignment document. Furthermore, page 3, line 1 of the October 15, 2003 Office Action admits, "The applied reference has a common assignee with the instant application." Since the Stamm patent is assigned to the same entity as the present application, 35 USC §103(c) prohibits the use of §102(e) art in support of a rejection

under §103. The rejection of claims 9, 12-36, 42-45, 48-53, and 56-61 under 35 USC §103 over Stamm is improper and contrary to 35 USC §103(c), and thus should be withdrawn.

#### Other Claim Issues

Claims 1, 3, 5-17, and 19-61 are pending, with claims 2, 4, and 18 having been cancelled in an earlier response. The October 15, 2003 Office Action rejected claims 1, 3, 5-8, 10, 11, 37, 39-41, 46, 47, 50, 51, and 54-57 under 35 USC §102(e), and rejected claims 9, 12-36, 42-45, 48-53, and 56-61 under 35 USC §103(a).

Please note that claim 18 was previously cancelled, so the rejection under §103 should not have included claim 18. Also, claim 38 is not mentioned in the Office Action, so its status is uncertain. In addition, claims 50, 51, 56, and 57 were apparently rejected under both §102 and §103. Please clarify the status of these claims.

#### Conclusion

It appears to the Applicants that the present application is now in condition for allowance. If the Examiner has any questions, please call the undersigned at 415-512-1312 x109.

Respectfully submitted,

STALLMAN & POLLOCK LLP

Dated: February 9, 2004

By: 

Stephen M. Everett  
Reg. No. 30,050

Attorneys for Applicant(s)